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Federal Agencies

November 4, 2002

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Art Unit 1642

Commissioner for Patents Washington, D.C. 20231

Re:

U.S. Utility Patent Application

Appl. No. 09/720,086; 102(e): July 23, 2001

De Novo DNA Cytosine Methyltransferase

Genes, Polypeptides and Uses Thereof

Inventors:

Li et al.

Our Ref:

0609.4560002/JAG/KRM

RECEIVED

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**TECH CENTER 1600/2900** 

Sir:

Transmitted herewith for appropriate action are the following documents:

1. Reply to Restriction Requirement; and

2. One (1) return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Karend. Marlowit

Karen R. Markowicz Agent for Applicants Registration No. 36,351

KRM/DJN:drb Enclosures SKGF\_DC1:71294.1

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Confirmation No. 6968

Art Unit:

Examiner: Harris, A.M.

Atty. Docket: 0609.4560002/JAG/KRM

In re application of:

Li et al.

Appl. No. 09/720,086

102(e): July 23, 2001

For:

De Novo DNA Cytosine Methyltransferase Genes, Polypeptides and Uses Thereof

Reply To Restriction Requirement RECEIVED

Commissioner for Patents Washington, D.C. 20231

NOV 0 5 2002 TECH CENTER 1600/2900

Sir:

In reply to the Office Action dated **October 2, 2002**, requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the invention of Group I, represented by claims 1-10 and 13. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

Applicants reserve the right to file one or more divisional applications directed to non-elected subject matter should this requirement be made final. In such case, Applicants retain the right to petition from this Restriction Requirement under 37 C.F.R. § 1.144.

This election is made with traverse.

As a threshold matter, Applicants point out that MPEP § 803 lists the criteria for a proper restriction requirement:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(i)) or distinct (MPEP § 806.05 - § 806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Thus, even assuming, arguendo, that the groups listed by the Examiner represented distinct or independent inventions, restriction remains improper unless it can be shown that the search and examination of both groups would entail a "serious burden." See M.P.E.P. § 803. In the present situation, no such showing has been made. Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

It is not believed that extensions of time are required<sup>1</sup>, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted, STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Karer R. Marhowitz

Karen R. Markowicz Agent for Applicants Registration No. 36,351

Date: 11 4 0 Z 1100 New York Avenue, N.W. Suite 600 Washington, D.C. 20005-3934 (202) 371-2600

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<sup>&</sup>lt;sup>1</sup>Applicants note that the initial deadline for response is November 2, 2002, a Saturday. Thus, Applicants filing on November 4, 2002 is timely.